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SIDLEY AUSTIN LLP
717 NORTH HARWOOD
SUITE 3400
DALLAS, TX 75201

EXAMINER

POON, KING Y

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKENORI IDEHARA

Appeal 2008-0309
Application 09/082,127
Technology Center 2600

Decided: June 18, 2008

Before, ANITA PELLMAN GROSS, ROBERT E. NAPPI, and KARL D.
EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 9-22, 25-27, 33-35, 37-41, and 56-59. No other claims are pending. (Br. 2). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

According the Appellant, the invention relates to input-output apparatus selecting methods for connecting computers and input-output apparatuses and a machine readable medium for implementing the methods. (Spec. 1).

Claims 9, 14, 38, and 56 are representative of the claims on appeal:

9. A machine readable medium on which is recorded a program for selecting a desired input-output apparatus from a plurality of input-output apparatuses connected to a network, said program comprising:

a first display step for classifying said input-output apparatuses into a plurality of categories with different functions and displaying said categories on a display as items to be selected; and

a second display step for displaying on said display as items to be selected only said input-output apparatuses classified in a category selected by a user.

14. A machine readable medium on which is recorded a program for selecting a desired input-output apparatus from a plurality of input-output apparatuses connected to a network, said program comprising:

a first display step for classifying said input-output apparatuses into a plurality of categories with different pieces of user identification information and for displaying on a display as items of selection said pieces of user identification information; and

a second display step for displaying on said display as items of selection only said input-output apparatuses in a category corresponding to a thus displayed user identification information which is selected by a user.

38. A machine readable medium on which is recorded a program for a network system connecting a plurality of computers and a plurality of input-output apparatuses, said program comprises:

a user name displaying step for displaying as items of selection the names of users regularly using said network system;

a user name selecting step for selecting one of said names displayed at said user name displaying step;

an input-output apparatus displaying step for displaying as items of selection only said input-output apparatuses associated with one of said users with the name thereof selected at said user name selecting step; and

an input-output apparatus selecting step for selecting as an input-output destination a desired one of said input-output apparatuses displayed at said input-output apparatus displaying step.

56. A program that can be read by a computer which has a computer execute the steps of:

selecting a first printer, as an output destination of image data, from among a plurality of printers connected to a network;

determining whether said first printer is currently available or not; and
selecting a second printer automatically, from a plurality of printers connected to a network, as a substitute output apparatus in response to the determination that said first printer is not available.

The Examiner relies on the following prior art references to show unpatentability:

Blair

US 5,809,265

Sept. 15, 1998,

filed Jan. 19, 1996

Sugiyama

US 5,996,029

Nov. 30, 1999, filed
Oct. 15, 1996

Jackson, B.K. (Jackson), "Methodology for Automated Printed Selection," IBM Technical Disclosure Bulletin, Vol. 36, No. 09B, p. 379 (Sept. 1993).

1. Claims 9, 11, 12, 19-22, 25, 27, 33, 37-41, 56, 58, and 59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Blair.
2. Claims 14, 16, 17, 26, 34, 35, and 57 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the collective teachings of Blair and Jackson.
3. Claims 10 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the collective teachings of Blair and Sugiyama.
4. Claims 15 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the collective teachings of Blair, Jackson, and Sugiyama.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Brief and the Answer for their respective details.¹ In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 1.192(c)(7)(July 1, 2002)²

¹ We refer to the Appeal Brief filed May 27, 2003 (Br.) and the Examiner's Answer mailed August 13, 2003 (Ans.).

² The rule, controlling at the time of Appellant's filing of the Brief, requires specific assertions of error – implying waiver in the absence thereof.

FINDINGS OF FACT (FF)

1. Blair's network management system allows an end user to select from a graphical user interface (GUI) display one or more output devices including printers, faxes, plotters, drives, storage devices, modems, and workstations to establish a virtual connection between the device(s) and the end user's workstation (col. 2, ll. 40-67, col. 3, ll. 45-59).
2. Each output device is represented by a GUI displayed selectable button describing the type of device. For example, for printers the button indicates "color, high speed, etc." (Blair, col. 2, ll. 56-57). Clicking on a button establishes a connection between a work station and the selected output device (Blair col. 2, ll. 65-67, col. 5, ll. 2-12).
3. The GUI presents the end user with a map of output devices within buildings and, more specifically, on floors and wings and within offices of the buildings. Employing a clicking device such as a mouse triggers a display of the name of the portion of the location under the mouse location (prior to clicking) and also creates a close up or localized wing or office section of the building (after clicking). The close up reveals buttons each of which represents the approximate location of the various selectable output devices within the wing or office selected. (Blair, col. 2., ll. 40-67, col. 4, ll. 46-60, Figs. 3-10).

OPINION

The Anticipation Rejection

We first consider the Examiner's anticipation rejection of claims 9, 11, 12, 19-22, 25, 27, 33, 37-41, 56, 58, and 59 over the disclosure of Blair. Anticipation is established only when a single prior art reference discloses,

expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

Claims 9, 11, 12, 25, 33, and 37

On page 10 of the Brief, Appellant presents arguments directed to the group of claims 9, 11, 12, 25, 33, and 37; we select claim 9 as representative of the group. Appellant disputes the Examiner's determination (Ans. 3-4) that Blair meets independent claim 9. Specifically, Appellant argues that Blair does not disclose the first step of displaying categories of devices by function nor the additional step of displaying only certain devices that are in a category selected by a user. (Br. 10). We disagree.

As the Examiner determined, Blair meets "a first display step for classifying the input-output apparatuses into a plurality of categories . . . with different functions, . . . and displaying said categories . . . on a display as items to be selected" by disclosing a GUI display of buttons representing different selectable devices such as printer, fax, and workstation input/output apparatuses classified according to the respective categories with different functions of printing, faxing, storing, etc. (Ans. 3, citing Blair, col. 2, ll. 40-67, FF 1-2).

We also generally agree with the Examiner's position that Blair's Figure 6 corresponds to a teaching of the second step (Ans. 3-4). Only certain devices, i.e., printer types LJ2 and 4si, are displayed in the GUI depicted in Figure 6 as located in the user selected Foothill 2/2 wing-level

location of a certain building (col. 5, ll. 21-28, col. 6, ll. 61-65, *see* FF 3). We determine that these displayed printers constitute the *only* displayed items to be selected and classified in a *location* (i.e., Foothill 2/2) category selected by a user - thereby meeting the claimed second step, contrary to Appellant's argument.³ That is, we determine that "a category selected by a user" in the second step of claim 9 does not necessarily refer to "said categories" of the first step. In summary, Blair categorizes different apparatuses by printing, faxing, and storing, etc. functions meeting the first step and displays only said apparatuses selected and classified in a location category, meeting the second step.

Blair's more specific disclosure of displaying only printers on different floor locations also meets both claim steps. For example, the printers at Figure 6, classified into a plurality of categories of functions of printer speed designated by LJ and 4si, are displayed as items to be selected, meeting the first claim step (col. 5, ll. 21-28, FF 2). Meeting the second step are selectable printers in a second display of different selectable locations, such as "Floor 10" or "Local" printers (Blair, col. 5, l. 56 to col. 6, l. 6, Figs. 9-10). Consequently, the Local (Fig. 10) or Floor 10 (Fig. 9) printers are, as claimed, "for displaying on said display as items to be selected" for connection to a user's computer, and "only" the Floor 10 or Local printers 4si, 4+, and 4/4m, etc. displayed are "classified in a [location] category selected by a user" (Figs. 9-10, col. 5, l. 56 to col. 6, l. 6, *see* FF 3). For the forgoing reasons we sustain the Examiner's rejection of claims 9, 11, 12, 25, 33, and 37.

³ Implicitly, only those printers at a given location and displayed on the GUI are available for selection at that selected location.

Claims 19-22, 27, 56, 58, and 59

On page 11 of the Brief, Appellant presents arguments directed to the group of claims 19, 27 and 56, from which claims 20 through 22, 58, and 59 depend; we select claim 56 as representative of the group. Appellant also disputes (Br. 10-11) the Examiner's determination (Ans. 7, 18-19) that Blair meets claim 56. The Examiner points to a prior art system disclosed in a patent to Lobiondo (U.S. 5,287,194 as described by Blair at column 1, line 65 to column 2, line 7, as teaching the claimed system (Ans. 18). We agree with the Examiner.

We find that Lobiondo's system, as described by Blair, meets the claimed steps. As the Examiner stated, Lobiondo's system "teaches automatically scheduling print jobs over a network to printer devices when they are available." (Ans. 18, quoting Blair, col. 1, ll. 65-67 and col. 2, ll. 1-7). Thus, Appellant's contention that Blair does not teach that "a substitute apparatus is automatically selected" (Br. 11) is not persuasive. We also determine that Lobiondo's system, described further in Blair as "concerned with detecting when print queues are busy and diverting print jobs (or portions of print jobs) to other printers on the network" (Blair, col. 2, ll. 5-7), reasonably meets the claim steps of "selecting a first printer . . . from among a plurality of printers connected to a network; determining whether said printer is currently available or not; and selecting a second printer automatically . . . in response to the determination that said first printer is not available." For the forgoing reasons we sustain the Examiner's rejection of claims 19 through 22, 27, 56, 58, and 59.

Claims 38-41

On pages 12 and 13 of the Brief, Appellant presents arguments directed to the group of claims 38 and 41 from which claims 39-40 depend; we select claim 38 as representative of the group. Appellant also disputes (Br. 12) the Examiner's determination (Ans. 5-6) that Blair meets claim 38. The central dispute is over whether the claimed "user name" is met by Blair's wing location names such as "Foothill 2/2" or "Foothill Sierra 2 Bridge," as the Examiner determined. (*See* Br. 10, Ans. 5-6, 19, Blair, Figs. 4, 6). We agree with the Examiner that each separate location name reasonably represents regular network users of the printers at those locations. (*See* Ans. 19-20). That is, we find it reasonable to refer to a group of printer users, which, as a group, necessarily "regularly" use the network printers located at a location such as Foothill 2/2 (Fig. 5) or Foothill Sierra 2 Bridge (Fig. 4), etc., as the Foothill 2/2 or Foothill Sierra 2 Bridge users. Thus, a location name constitutes a user name in the manner claimed.

Consequently, pointing a mouse over a particular wing location triggers the display of the name(s) of selected location(s) (Blair, col. 4, ll. 46-60, Figs. 4-5, FF 3) and thereby meets the user name displaying step.⁴ Next, selecting a particular wing location, such as Foothill 2/2 (Fig. 6, *see* FF 3), meets the user name selecting step, and also meets the input-output apparatus (i.e., LJ2, 4si) displaying step for reasons similar to those discussed *supra* for claim 9. Last, selecting one of the printers LJ2 or 4si meets the final selecting step (*see* FF 2).

⁴ For example, Blair's Figure 4 depicts a mouse triggered display of the wing location "Foothill Sierra 2 Bridge" located at 650 Page Mill, Floor 2 (col. 4, ll. 46-60). *See also* Figures 8-10 displaying as items for selection the location names "Local Printers" and "Building 2" (col. 5, l. 56-col. 6, l. 6).

Moreover, the claimed data type, i.e., “a user name,” does not functionally change Blair’s prior art program over how it operates with respect to the Foothill 2/2, Local, etc., or other location data and, thus, constitutes non-functional descriptive material. Non-functional descriptive material cannot render patentable an otherwise unpatentable product or process. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (Informative Opinion) (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006) (“Common situations involving non-functional descriptive material [include] . . . a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer) . . .”).

Therefore, we are not persuaded by Appellant’s arguments that “Blair is silent with regard to displaying *names* of users[,]. . . providing for selecting one of some *names* displayed[, and]. . . displaying only input-output devices associated with a *name* that has been selected from a list of displayed *names*.” (Br. 12, emphasis supplied). Replacing “*name*” and “*names*” in Appellant’s arguments just quoted respectively with “*location name*” and “*location names*” reveals that Blair meets the argued steps.⁵

⁵ Similarly, replacing “user” or “users” in claim 38 respectively with “location” and “locations” reveals that Blair meets the claimed steps. Hence in claim 38, “a *user* name displaying step . . .” becomes “a *location* name displaying step for displaying as items of selection the names of *locations* regularly using said network system. . .” We determine that under one interpretation, the phrase “for displaying . . . the names of users *regularly using said network*” merely describes the “user name” data displayed in the displaying step. Consequently, Blair’s location data does not alter the

For the foregoing reasons, we sustain the Examiner's rejection of claims 38 through 41.

The Obviousness Rejections

We now consider the Examiner's obviousness rejections of claims 10, 13-18, 26, 34, 35, and 57. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

If the Examiner's burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Claims 14, 16, 17, and 26

On pages 13 and 14 of the Brief, Appellant presents arguments directed to the group of claims 14, 16, 17, and 26, we select claim 14 as representative of the group. Appellant disputes (Br. 13-14) the Examiner's determination (Ans. 8-9) that the combination of Blair and Jackson meets claim 14. Similar to the issue involved in claim 38, the issue here also involves non-functional descriptive material. That is, Appellant argues that categorizing/displaying according to user identification is patentably distinct from categorizing/displaying according to physical location. (Br. 13-14).

claimed program, nor does the claimed data type alter Blair's system. (Our alternative interpretation of "regularly using" is described *supra*.)

For reasons similar to our determination *supra* involving claim 38, we determine that the type of data claimed creates no patentable distinction over the Blair program as identified by the Examiner (Ans. 8-9). The claimed data type does not alter the manner in which Blair's program operates.⁶ Appellant cannot obtain a patent merely by replacing the type of data displayed.

We also alternatively concur with the Examiner's determination that Jackson would have rendered such a data type substitution obvious (Ans. 8-9). Correlating printer types with user identification data would have involved no more than the predictable step of replacing printer locations with user identification. Jackson teaches correlating a user's terminal identification data with its physical location in order to allow an end-user to find the nearest available compatible printers and to display a list thereof (Jackson, 379), while Blair similarly teaches selecting a local (near) compatible printer from a displayed list thereof (Blair, col. 5, l. 65 to col. 6, l. 6).

Thus, Appellant's assertion that Blair's and Jackson's teachings are limited to correlating a user's location with a terminal ID (Br. 13-14) is not correct. In concurrence with the Examiner's finding, we determine that displaying a list of printers versus users would have been obvious in order to provide feedback to an end-user attempting to connect to the nearest compatible and available printer (*see* Ans. 21-22). Such a correlated list also

⁶ Moreover, under another interpretation, wing locations such as "Foothill Sierra 2 Bridge" (Fig. 4), "Foothill 2/2" (Fig. 6), or "Local" (Fig. 10), constitute "different pieces of user identification information" for reasons similar to those involved in our analysis of "user names" discussed *supra* with regard to claim 38.

would have been predictably beneficial for system planners/engineers planning for additional printers according to projected needs or maintaining the existing network.

Appellant does not separately argue the Examiner's obviousness rejection of claims 16, 17, and 26 over the collective teachings of Blair and Jackson with particularity, but relies instead on the same arguments relied upon for claim 14 (Br. 13-15). For the reasons discussed above with respect to claim 14, the Examiner's rejection of claims 16, 17, and 26 is therefore sustained.

Claims 34, 35 and 57

Appellant also does not provide any arguments regarding Jackson, but relies instead on the same arguments relied upon for claims 33 and 56, respectively (Br. 15, 18). For the reasons discussed above with respect to claim 9 (with which claim 33 was grouped) and 56, the Examiner's rejection of claims 34, 35, and 57 is therefore sustained.

Claims 10 and 13

Likewise, Appellant does not provide any arguments regarding Sugiyama, but relies instead on the same arguments relied upon for claim 9 (Br. 16-17). For the reasons discussed above with respect to claim 9, the Examiner's rejection of claims 10 and 13 is therefore sustained.

Claims 15 and 18

Similarly, Appellant does provide any arguments regarding Jackson or Sugiyama but relies instead on the same arguments relied upon for claim 14 (Br. 17). For the reasons discussed above with respect to claim 14, the Examiner's rejection of claims 15 and 18 is therefore sustained.

DECISION

We have sustained the Examiner's rejections with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 9-22, 25-27, 33-35, 37-41, and 56-59 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2008-0309
Application 09/082,127

AFFIRMED

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SIDLEY AUSTIN LLP
717 NORTH HARWOOD
SUITE 3400
DALLAS, TX 75201